

## REMARKS

In the Official Action of March 15, 2006, claims 1-26 were rejected under 35 U.S.C. § 103(a) as obvious over Perdelwitz, Jr. et al. (U. S. Patent No. 5,968,855) in view of Ahr et al. (U. S. Patent No. 4,323,059). This rejection is respectfully traversed.

The Examiner states that the Perdelwitz et al. reference discloses all aspects of the claimed invention with the exception of the apertured film disposed between the inner layer of the garment and the absorbent core. The Examiner also contends that it would be obvious for one skilled in the art to construct the absorbent articles of Perdelwitz et al. with the apertured film of Ahr et al. to arrive at the present invention. Applicant respectfully disagrees with this conclusion.

Three criteria must be met to establish a prima facie case of obviousness: (1) there must be some suggestion or motivation to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations MPEP § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In connection with an obviousness determination, the motivation required to combine references to teach a feature must also show that the feature to be substituted is desirable in terms of the combination urged, not merely feasible. *Winner Int'l. Royalty Corp. v. Ching-Rong Wang*, Docket No. 98-1553 (Fed. Cir. 2000). Even if a prima facie case of obviousness has been established, it can be successfully rebutted by evidence of unexpected results. See MPEP 716.02.

The Examiner has criticized the Declaration of Prelo Hood under 35 U.S.C. 132 on the basis that the comparison made in the Declaration is between the articles of the present invention (with an apertured film), and those of Perdelwitz et al. (no apertured film). The Examiner contends that this is an incorrect comparison, and that the true comparison should be between the articles of the present invention, and a hypothetical article including the apertured film. Applicant strongly disagrees.

The hypothetical article as proposed by the Examiner would, in effect, be the same as the article of the present invention. Accordingly, any such comparison would be essentially meaningless. See *In re Chapman*, 148 USPQ 711, 714 (CCPA 1966).

Applicant continues to urge that the issue addressed by the Declaration is whether the results of such a substitution or modification would produce results which would be expected (changes in degree only) or unexpected (changes in kind). MPEP 716.02(a). The results set forth in the Declaration are clearly more than simply additive, as stated previously, and applicant therefore continues to maintain that this showing is effective to rebut any combination of the Perdelwitz et al. and Ahr et al. references.

More significantly, however, the proposed combination of the cited references would still fail to teach or suggest the present invention for the following reasons. The apertured film of the present invention and the absorbent core are wrapped in a tissue layer. The purpose of the tissue wrap is to provide improved strength and to facilitate manufacturing the article. See pages 10 and 11 of the specification. This feature is not disclosed in the references.

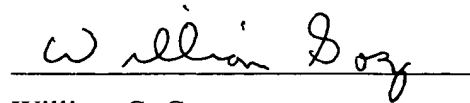
Although the Office Action states that Ahr et al. discloses, in FIG. 2, a tissue layer **36** surrounding the absorbent core **16** and apertured film **40**, applicants submit that this is an incorrect reading of the reference. In fact, Ahr et al. clearly states that **36** is a fiber layer, not a tissue layer. See col. 11 of Ahr et al.

Accordingly, the present application is now believed to overcome the remaining rejections, and to be in proper condition for allowance. Reconsideration of the rejections and allowance of this application are therefore respectfully solicited. Entry of the foregoing amendment is appropriate at this time since the amendment is based on an embodiment previously claimed and examined, and therefore creates no new issues.

The Examiner is invited to contact the undersigned at the telephone number listed below to facilitate the prosecution of this application.

Dated: June 26, 2006

Respectfully submitted,

A handwritten signature in cursive script, reading "William Gosz", is written over a horizontal line.

William G. Gosz

Reg. No. 27,787  
Attorney for Applicant  
Tel No. 781-863-1116